

Appl. No. 10/652,269
Office Action mailed February 25, 2005
Response transmitted March 25, 2005

Attorney Docket 10095/18

REMARKS

1. The Application was filed with 52 claims, all of which remain pending in the application. In the Office Action, the Examiner has required a restriction as between Group I, Claims 1-42, for a light transmitting device, and Group II, Claims 43-52, for an optical module with a photonic chip mounting region and a groove extending forward having an optical coupler. The stated reason for the restriction is that Group I and Group II are related as subcombinations usable together in a single combination. Office Action, p. 3, lines 1-2.

Applicants elect Group I and traverse the restriction requirement. The Office Action has not provided any example of how the inventions are usable together, i.e., what the single combination is or how it would function. Thus, there is no *prima facie* finding in the Office Action that the two "subcombinations" are indeed usable together as a combination.

In addition, the Office Action states that the Groups are distinct from each other if they are shown to be separately usable, and then states that the subcombinations are separately usable, Group I as an optical waveguide having graded index properties, and Group II as a mode stripper by biasing and directing various modes that are separated and coupled together. Office Action, p. 3, lines 2-6.

Applicants find can find no support for the uses offered for Group II in the claims or in the specification of the present application. In any event, Group II, as exemplified by Claim 43, also functions as a light transmitting device, as does Group I, having a graded index of refraction, because the optical module of Claim 43 also includes a plurality of alternating layers or discrete structures of a first material and a second material, the first material having a first index of refraction, and the second material having a second index of refraction different from the first index of refraction, the second material structures having at least one dimension substantially smaller than an effective wavelength of light.

Applicants submit that the Office Action fails to make out a *prima facie* case that the inventions of Groups I and II are disclosed as usable together. For instance, the Office Action does not state what the single combination is or how it would function. Therefore, the restriction requirement is improper, and Applicants respectfully request that the Examiner withdraw the restriction requirement.

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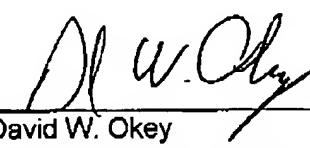
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2. Applicants also traverse the species restriction requirement, and elect Species 3. Per the Office Action, Claim 1 is generic, and thus reads upon all four species, and in addition, Claims 4, 10-20, 22-36, and 38-42, also read on Species 3.

The purpose of a restriction requirement is to lessen the burden on the Examiner of having to examine numerous claims. In this instance, there are only four species, and Applicants submit that there is at least one allowable linking claim, Claim 1, which relates all four species.¹ Applicants note that if Claim 1 is allowed, Applicants are entitled to examination of all the non-elected species. M.P.E.P. 809 at 800-48. It may therefore be less burdensome on the Examiner to examine all four species at once.

3. Applicants have traversed the restriction requirement on the grounds that the Office Action does not make out a *prima facie* case of a combination that would allow usage together of the alleged subcombination inventions Group I and Group II. Applicants elect Group I and Species 3, and note that Claims 1, 4, 10-20, 22-36, and 38-42, read on Species 3. Applicants respectfully request the Examiner to withdraw the restriction requirements and advance the application to examination of all the claims.

Respectfully submitted,



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¹ Note also that the Office Action lists Claim 3 as belonging to both species 1 and species 2, thus at least implying that Claim 3 is generic, or that "species 2" with only Claim 3, is not a distinct species.